

## REMARKS

Upon entry of the aforementioned amendments, claims 1-14 will be pending in the application.

Claims 1-11 were rejected by the Examiner in the Office Action of December 23, 2002. Applicants request reconsideration of this Office Action based upon the following comments.

### ***Objection to the Abstract***

Applicants have amended the Abstract to be more concise. As such, Applicants request that the objection be withdrawn.

### ***Objection to the Specification***

The Examiner noted that the word "plain" should be - -plain- -. Applicants agree with the Examiner's observation and request that pages 3 and 4 of the specification be amended. Applicants believe that the objection should be withdrawn in light of the specification amendments.

### ***Drawings***

Applicants have amended Fig. 6 to include the header - - PRIOR ART - -. Applicants request approval of this amendment.

***Claim Rejections – 35 U.S.C. § 102***

Claims 1-4 and 7-9 are rejected as being anticipated by Watanabe (US 5,127,074).

Applicants respectfully submit that the rejection should be withdrawn in light of the amendments to independent claim 1.

Independent claim 1 now details:

An optical semiconductor module comprising:

a mounting member, having an element mounting surface and a contacting surface, said element mounting surface and said contacting surface extending along a reference plane intersecting a predetermined axis;

a first member having a tubular portion, a first end portion and a second end portion, said tubular portion extending in a direction of the predetermined axis, said first end portion being provided at one end of the tubular portion and being mounted on said contacting surface of mounting member, said second end portion being provided at the other end of the tubular portion, said first end portion being bonded to said mounting member, and an outer edge of said first end portion being located inside of an edge of said mounting member;

an optical semiconductor element provided in the tubular portion of said first member such that an optical axis thereof is directed in a direction of said predetermined axis;

a second member having a tubular portion extending in a direction of the predetermined axis, said second member being mounted on the second end of said first member; and

an optical fiber optically coupled to said optical semiconductor element, said optical fiber extending in the tubular portion of said second member.

Support for the amendment can be found in the specification. The phrase “element mounting surface” is described in line 17, page 11 of the present specification. The phrase “a contacting surface” is described in line 3, page 15 of the present specification. Support for “an outer edge of said first end portion

being located inside of an edge of said mounting member” can be found in Fig. 2 and the associated description. The first end portion 30b of the first member 30 is located on the contacting surface 30e. Furthermore, the outer edge of the first end portion 30b is positioned inside the edge of the mounting member 20.

Applicants respectfully submit that Watanabe fails to disclose “an outer edge of said first end portion being located inside of an edge of said mounting member”. The optical package of Watanabe fails to depict this arrangement. The first member 12a and the laser holder 14 are both located outside the edge of reference part 32. Reference is made to Fig. 1 of Watanabe.

As such, Applicants respectfully submit that Watanabe fails to inherently or explicitly disclose each and every feature of the claimed invention. Independent claim 1 and dependant claims 2-4 and 7-9 are not anticipated by Akimoto.

#### **Claim Rejections-35 U.S.C. § 103**

Claims 5, 6, and 11 are rejected as obvious in light of Watanabe in view of Watanabe '834 (US 5,661,834).

Claim 10 is rejected as being obvious in view of Watanabe.

Applicants respectfully traverse these rejections.

As discussed above, independent claim 1 is not believed to be anticipated by Watanabe. Furthermore, Applicants submit that the Examiner has not established that independent claim 1 is *prima facie* obvious.

As such, Applicants respectfully submit that the two Watanabe patents fail to disclose all of the features of dependant claims 5, 6, 10 and 11. Therefore, these rejections should be withdrawn.

### CONCLUSION


Applicants respectfully submit that this response obviates the rejections detailed in the Office Action and that this application should be allowed.

If any additional fees are due in connection with the filing of this response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

Respectfully submitted,

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Signature:

  
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